UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte HANS-PETER WILD and EBERHARD KRAFT

Appeal No. 2005-2000
Application No. 09/690,409

ON BRIEF

Before GARRIS, WALTZ, and TIMM, *Administrative Patent Judges.*

TIMM, *Administrative Patent Judge.*

DECISION ON APPEAL

This appeal involves claims 1-6, all the claims pending in the application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

INTRODUCTION

The claims are directed to an apparatus for applying a drinking straw to a stand up bag. Claim 1 is illustrative of the subject matter on appeal:

> 1. In an apparatus for applying a drinking straw to a receiving surface of a stand up bag which is supplied on a conveying surface to a transfer means for drinking straws, the improvement comprising that the stand up bag lies with a side surface resting on the conveyor surface that is generally opposite said receiving surface (3a) and that said transfer means (5) is arranged such that the drinking straw (2) while being handed over encloses an acute angle (α) with the conveying surface (4a).

The Examiner rejects claims 1-6 under 35 U.S.C. § 102(b). According to the Examiner, the claims are anticipated by US Patent 4,584,046 issued to Geyssel on April 22, 1986 (Geyssel).

In reviewing this rejection, we consider the issues as presented in the resubmitted Brief filed November 5, 2003 (Brief), the Answer, and the Reply Brief. Appellants state that claims 1-4 stand or fall together and that each of claims 5 and 6 stand or fall separately (Brief, p. 4). We select claim 1 to represent the issues on appeal for the first group. To the extent that claims 5 and 6 are argued separately, we consider them separately.

We affirm with respect to all the claim groupings for the reasons advanced by the Examiner and add the following for emphasis.

OPINION

The Examiner's rejection is based upon the finding that Geyssel describes an apparatus for applying a drinking straw to a package, the apparatus including a transfer means (Fig. 9) that rotates a transfer drum 20 which applies a straw 11 to a package 12 as the package travels on a conveying surface 13. The Examiner finds that the transfer means is arranged so that the drinking straw, while being handed over, encloses an acute angle with the conveying surface as claimed.

With respect to claim 1, Appellants make the following argument:

> Independent claim 1 recites that "the stand up bag lies on a side surface resting on the conveyor surface that is generally opposite said receiving surface." The conveyor surface is that which moves the stand up bag through the apparatus. The receiving surface is that surface upon which the drinking straw is placed. The surface on which the bag lies is the surface ***opposite*** the straw receiving surface. Geyssel fails to disclose or suggest at least this limitation of independent claim 1. Claim 1 also recites that "the drinking straw (2) while being handed over encloses an acute angle (a) with the conveying surface (4a)." Geyssel fails to disclose or suggest this limitation of claim 1, when considered in light of the other recited surfaces.

(Brief, p. 5).

The Examiner responds that the receiving surface of the package 12 is "generally opposite" the surface that is resting on the conveyor and forming an acute angle with the conveying surface (Answer, p. 3). The Examiner further responds that the apparatus of Geyssel is described as tiltable about two perpendicular axes and that the straws can be secured in different directions and on various inclined surfaces of the package (Answer, p. 4). The Examiner further points out that the apparatus of

Geyssel is capable of attaching straws to a range of articles including packages, bottles, bags, etc (Answer, p. 4 citing Geyssel, col. 1, ll. 42-45). Lastly, the Examiner notes that the claims are directed to an apparatus and that the intended use of the apparatus does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations (Answer, p. 4).

We agree with the Examiner. As pointed out by the Examiner, the claim is directed to an apparatus. This apparatus is recited as including two structures: (1) a conveying surface; and (2) a transfer means. The stand up bag and the drinking straws are articles worked upon by the apparatus and are not a part of the apparatus itself. When interpreting claim 1 it is proper to consider the language relating to the configuration and position of the bag and straws to the extent that the language further limits the structure of the combination of the conveying surface and transfer means of the claim. The article itself, however, is not considered a part of the apparatus. *See In re Rishoi*, 197 F.2d 342, 345, 94 USPQ 71, 73 (CCPA 1952)("[T]here is no patentable combination between a device and the material upon which it works."); *In re Hughes*, 49 F.2d 478, 479, 9 USPQ 223, 224 (CCPA 1931)(A person may not patent a combination of a device and the material upon which the device works, nor limit other persons from the use of similar material by claiming a device patent. If the material which appellant uses here for printing is new to the art, then such material may be patentable; but he may not take advantage of this in applying for a patent upon a mechanism to apply it. Any feature of the mechanism which is particularly constructed

for the use of such a fluid might be patentable in combination or otherwise. Appellant cannot, however, properly claim a combination of device and material worked upon.); *In re Smith*, 36 F.2d 302, 303, 3 USPQ 315, 316 (CCPA 1929)(It might be argued that the invention here consists in a combination of extra length carbons with the old machine, and that such a combination is patentable. It will be borne in mind that it has been long established that a person may not patent a combination of device and material upon which the device works, nor limit other persons from the use of similar material by claiming a device patent.).

Given the above law with regard to claim interpretation, claim 1 does not require the presence of a bag laying on its side. That does not mean that the claim recitation directed to the orientation of the bag is meaningless, it simply means that it is only considered to the extent that it limits the structure of the apparatus. One way to identify how the claim recitation affects the structure is to consider whether the prior art apparatus is capable of applying a straw to such a bag. We agree with the Examiner that the apparatus of Geyssel is capable of applying a straw to a stand up bag lying on its side such that the straw is on the generally opposite side. This is because, as pointed out by the Examiner, Geyssel describes a pivot point 16 shown in Figure 1 and Geyssel further discloses that the applicator element (transfer drum) can be placed in any desired angular position against the objects (bags) to which the articles (straws) are to be secured (Geyssel, col. 2, ll. 19-32). Moreover, Figure 9 depicts an acute angle between the transfer means (transfer drum or wheel 20) and the conveying device 13.

Through the tilt mechanism, this apparatus is capable of applying a straw to the claimed "generally opposite" side of a stand up bag lying on its side as claimed.

We also agree with the Examiner's reasoning that the placement of the stand up bag on its side on the conveyor reflects an intended use of the apparatus. How an apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitations of what is claimed. *Ex parte Masham*, 2 USPQ2d 1647, 1648 (Bd. Pat. App. & Int. 1987); *see also In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and cases cited therein.

With respect to claims 5 and 6, Appellants arguments are directed to the configuration of the stand up bag. These arguments fail for the reasons discussed above.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 1-6 under 35 U.S.C. § 102(b) is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(2004).

AFFIRMED

BRADLEY R. GARRIS
Administrative Patent Judge

THOMAS A. WALTZ
Administrative Patent Judge

CATHERINE TIMM
Administrative Patent Judge

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CT/tf

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